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PTO/SB/33 (07/05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

112740-112

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR

on January 9, 2006

Signature

Typed or printed name

Heather Foster

Application Number

09/647,431

Filed

October 2, 2000

First Named Inventor

Andreas Klug

Art Unit

2662

Examiner

Donald L. Mills

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.Registration number 48,196☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Peter Zura

Typed or printed name

312-807-4208

Telephone number

January 9, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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		Andreas Klug	
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		2662	Donald L. Mills
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<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		<u>312-807-4208</u> Telephone number	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>48,196</u>		<u>January 9, 2006</u> Date	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Andreas Klug
Appl. No.: 09/647,431
Conf. No.: 8643
Filed: October 2, 2000
Title: METHOD AND APPARATUS FOR COUPLING AN ATM
COMMUNICATION LAYER TO A PLURALITY OF TIME-DIVISION
MULTIPLEX COMMUNICATION TERMINALS
Art Unit: 2662
Examiner: Donald L. Mills
Docket No.: 112740-112

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated September 9, 2005.
This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

Claims 11-20 are pending in the present application. The claims were not amended pursuant to this request, and none have been made subsequent to the mailing of the final office action dated September 9, 2005. Claims 11 and 20 are independent claims and are the focus of the present request.

Claims 11-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Irwin* (US Patent 5,862,136). Applicant traverses the rejection. Favorable reconsideration is respectfully requested.

Specifically, *Irwin* does not teach or suggest “generating a control signal sequence with a clock rate corresponding to the overall payload cell rate CR_N of the N time-division multiplex communication terminals, whereby control signals in the control signal sequence represent one of a first and a second status” as recited in claim 11 and similarly recited in claim 20. It follows that *Irwin* also fails to teach or suggest “transmitting, on demand, an ATM cell from the ATM waiting list to the requesting time-division multiplex communication terminal when a respectively oldest control signal of the control signal sequence represents the first status, and transmitting the fixed data pattern to the requesting time-division multiplex communication terminal when the oldest control signal of the control signal sequence represents the second status; and deleting the oldest control signal of the control signal sequence.”

The Examiner conceded that *Irwin* does not disclose *generating a control signal sequence* with a clock rate corresponding to the overall payload cell rate CR_N of the N time-division multiplex communication terminals, whereby control signals in the control signal sequence *represent one of a first and a second status* (see Final Office Action page 3, second full paragraph). Oddly enough, the Office Action goes on to claim that *Irwin* teaches transmitting, on demand, an ATM cell from the ATM waiting list to the requesting time-division multiplex communication terminal when a respectively *oldest control signal of the control signal sequence represents the first status*, and transmitting the fixed data pattern to the requesting time-division multiplex communication terminal when the *oldest control signal of the control signal sequence represents the second status*. Applicant repeats that such a position is untenable in light of the disclosure in *Irwin*, and is furthermore inconsistent on its face.

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986) (MPEP 2141). Applicant respectfully submits that none of these requirements were met in the present Office Action.

If *Irwin* does not disclose a control sequence as claimed by the Examiner, how can *Irwin* also teach the feature where the oldest control signal assumes different states as recited in the claims? The Office Action cites FIG. 6, and argues that, since read counter 422 has limited storage capacity, an oldest signal is determined and removed (page 3 Office Action, lines 4-5). This is simply wrong. As the read counter is explicitly used to help control buffer traffic (col. 6, lines 58-65), the counter has nothing whatsoever to do with determining the oldest control signal. By definition, the read counter counts the read requests from the buffers – while a counter presumably has a non-infinite counting capacity, this fact has no relevance to the present claims. Furthermore, it is not understood how the counter determines whether a control signal takes on a first or second status as required by the claims. Even using the Examiner's interpretation that the "oldest signal" in the read counter is deleted, there is nothing in *Irwin* that shows any processing of this signal, other than the FIFO architecture that is used to store the read requests.

Moreover, *Irwin* does not disclose a fixed data pattern. The passage in *Irwin* cited by the Examiner (col. 15, lines 48-49) describes how surplus bandwidth, which is transmitted by idle coded octets (i.e., bytes), is inserted into idle time slots by the input multiplexer. There is absolutely nothing in this passage, nor anywhere else in *Irwin* that these octets are in the form of fixed data patterns.

Finally, the Applicant asserts that the Office Action's claim that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a control signal sequence in the system of *Irwin*" is simply incorrect. Applicant can only presume that the Examiner discovered something inherent in the disclosure or *Irwin* (aside from the fact that ATM transmission occurs) that served as a basis for the obviousness contention. However, this basis is completely lost on the Applicant, and objective evidence for this position was wholly absent from the Office Action. As was argued previously, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In Re Rijckaert* 9 F.3d 1531, 1534, 28 USPQ2d 1955 (Fed. Cir. 1993) MPEP §2112. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex Parte Levy* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), MPEP §2112.

Independent claims 11 and 20 are not simply reciting the bare transmission of ATM cells over time slots, but recite specific elements for coupling an ATM communication layer to a plurality of TDM terminals. By baldly asserting that "one could have easily used a control sequence to instruct the mechanism to output cells over time slots" using conclusory reasoning demonstrates that the rejection is improper and should be withdrawn.

In light of the above, Applicant respectfully submits that claims 11-20 of the present application are both patentable over the art of record, and respectfully requests that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Office is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-112) on the account statement.

Appl. No. 09/647,431
Notice of Appeal and Pre-Appeal Brief Request
Responsive to Final Office Action date September 9, 2005

Respectfully submitted,

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Dated: January 9, 2006